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PATENT

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 09/862,636 Confirmation No. 1483  
Applicant : GOLDFAIN, et al.  
Filed : May 22, 2001  
Title : Eye Viewing Device Comprising Eyepiece and Video Capture Optics  
TC/A.U. : 3737  
Examiner : SANDERS JR., JOHN R.  
Docket No. : 281-329.02  
Customer No. : 20874

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COMMUNICATIONS

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Post Office Box 1450  
Alexandria, VA 22313-1450

**Petition to Withdraw Holding of Abandonment Under M.P.E.P. §711.03(c) II  
Based on Failure to Receive Office Action**

Sir:

Applicants respectfully petition that the holding of abandonment for the above-referenced patent application be withdrawn under M.P.E.P. §711.03(c) II. Applicants petition to reopen prosecution. In support of this petition, please consider the following:

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1. A first Notice of Allowance and Issue Fee Due was mailed from the U.S. Patent and Trademark Office on June 13, 2003.
2. On September 12, 2003, a Request for Continued Examination ("RCE"), submitting an Information Disclosure Statement, was sent to the U.S. Patent and Trademark Office.
3. Our records indicate that no second Notice of Allowance was received. However, the Patent Office maintains that a second Notice of Allowance was mailed on November 15, 2003. We still have not received this November 15, 2003 Notice of Allowance in spite of several request for a copy of the purported November 15, 2003 Notice of Allowance.

Filed: May 22, 2001

Attorney Docket No.: 281-329.02

Reply to Notice of Abandonment mailed 03/31/2004

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4. The next correspondence received from the U.S. Patent and Trademark Office in connection with this application was one page of Supplemental Notice of Allowability mailed on January 15, 2004. The Supplemental Notice of Allowability stated the following:

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by applicant. See 37 CFR 1.313 and MPEP 1308.

5. In addition, section No. 1 of the Supplemental Notice of Allowability mailed January 15, 2004, states that "This communication is responsive to Paper No. 18, filed 15 September 2003," presumably acknowledging receipt of the RCE mailed in the subject application on September 12, 2003. Applicants expected that a Notice of Allowance would be issued.

6. The following correspondence received from the U.S. Patent and Trademark Office was a Notice of Abandonment, mailed March 31, 2004, indicating that the application had become abandoned for failure to pay the issue fee and publication fee within the statutory time period of three months from the mailing date of the Notice of Allowance.

7. After receipt of the Notice of Abandonment, we diligently examined our corresponding file and docket records to determine if the Notice of Allowance had been received by us. Such a notice was not found in the corresponding file, and our docket records do not reflect receipt of such a notice. Please refer to the attached Declarations under 37 C.F.R. §1.68 of Cheryl Nichols and Kathleen Mulligan-Piraino. Ms. Nichols was a docketing clerk in our docket department at the time the U.S. Patent and Trademark Office apparently mailed the second Notice of Allowance. Ms. Nichols had been a docketing clerk in our docket department for two years. Ms. Mulligan-Piraino, our current docketing clerk, has been the docketing clerk since December 2003. As mentioned in their declarations, there is no record of our docketing department ever having received the (second) Notice of Allowance for this application. Accordingly, our records indicate that a Notice of Allowance was never received by us.

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8. Attached to the Declarations under 37 C.F.R. §1.68 of Cheryl Nichols and Kathleen Mulligan-Piraino is a relevant "Patent Chronological Docket" report (pages 25-27) generated for Wall Marjama & Bilinski LLP for February 13, 2004 through February 16, 2004, covering the date range that the Issue Fee and Publication Fee would have been due had the second Notice of Allowance been received. The docket actions are listed by due date. A docket date corresponding to the Notice of Allowance would have appeared on pages 25 or 26 with a Due Date of February 15, 2004 had there been a pending due date known to us, since the docket report is sorted by due date.

9. Since a (second) Notice of Allowance was not received according to our records, Applicants were unable to file a timely response. As the delay in responding to the Notice of Allowance was unavoidable, we hereby petition the Commissioner for Patents to withdraw the holding of abandonment, in view of *Delgar v. Schuyler*, 172 USPQ 513 (DDC 1971), MPEP §711.03(c) II, and 1156 OG 53, November 16, 1993. Copies of *Delgar* and MPEP §711.03(c) II are enclosed for ease of reference. The *Delgar* case suggests that in appropriate cases, the Commissioner for Patents may authorize the Examiner to withdraw a holding of abandonment.

10. To my knowledge Wall Marjama & Bilinski LLP, in seven years of existence, has never had to petition the U.S. Patent and Trademark Office for revival based on a failure to receive an Office action.

In response to the purported November 15, 2003 Notice of Allowance, Applicants submit the following:

(a) A Request for Continued Examination (a second RCE filed in the present application);

(b) An Information Disclosure Statement to submit U.S. Patent No. 4,856,891.

Pursuant to a diligent review, Applicants found that U.S. Patent No. 4,856,891 was cited in a related Chinese application, and wish to have the reference considered.

Filed: May 22, 2001

Attorney Docket No.: 281-329.02

Reply to Notice of Abandonment mailed 03/31/2004

Petition to Withdraw Holding of Abandonment Under M.P.E.P. §711.03(c) II

Based on Failure to Receive Office Action

It is respectfully requested that the Director charge \$950 to the undersigned's Deposit Account for the RCE (\$770) and Information Disclosure Statement (\$180) fees due. As noted above, Applicants have received neither the purported Notice of Allowance mailed November 15, 2003 nor a photocopy of the same despite several telephone and electronic requests to the U.S. Patent and Trademark Office. For this reason, Applicants are relying on information provided, in telephone conversations, by Examiner John Sanders of Art Unit 3737 and Tom Hawkins who issued the Notice of Abandonment, for confirmation of the November 15, 2003 mailing date for the subject Notice of Allowance.

Facts showing that the entire delay in filing the required reply was unavoidable, from the due date for reply until the filing of the present petition, are set forth above and substantiated by the attached Declarations under 37 C.F.R. §1.68 of Cheryl Nichols and Kathleen Mulligan-Piraino.

The Director is authorized to charge Deposit Account No. 50-0289 for any additional fees pursuant to this correspondence.

Respectfully submitted,

WALL MARJAMA & BILINSKI LLP

Date: May 4, 2004

By:



George S. Blasiak

Reg. No. 37,283

Telephone: (315) 425-9000

Fax: (315) 425-9114

Enclosures

**Customer No. 20874**